REMARKS

Claims 9, and 15-22 are in the case.

Claim 9 was objected to because the second occurrence of the phrase "computer readable medium" did not refer back to the first occurrence. This rejection is obviated by the current amendment which changes the introductory phrase to "An article comprising a computer readable medium having computer program code tangibly stored in a the computer readable medium executable by a computer comprising a set of instructions for assessing institutional food service needs on a campus according to the following steps."

Claims 9 and 15-22 were rejected under 35 U.S.C. 112 as failing to comply with the enablement requirement regarding steps c) (identifying each need not met by current services as an opportunity gap;) and d) (for each geographic unit and day part, generating optimal facility locations and one or more optimal services corresponding to the facility locations and day parts selected from the group consisting of brands, hours, design layouts, and meal plans). In response, claim 9 has been amended to delete paragraph c). One of normal skill in this art would understand step d) and would know how to carry it out without undue experimentation.

It should be pointed out that Examiner Cardenes-Navia and Supervisory Primary Examiner Bayat suggested the exact language of claims 9, 15, and 18 during the personal interview on June 23, 2009, with Ms. Royale, one of the inventors, and the undersigned. Applicants do not understand why the language was found to be acceptable, enabled, and supported by the specification during the personal interview and has now found to be non-enabled and therefore applicants request reconsideration of the holding with regard to former paragraph d) which is now paragraph c). The language and steps of subparagraph c) are easily accomplished with appropriate, easily designed algorithms, as is conventional in the field of computer science. The concept set forth in this subparagraph is to calculate with the algorithm(s) the most cost effective and profitable facility locations and services to be offered at those locations at each time of day, e.g., lunch, breakfast, dinner, after dinner, between meals, days of weeks, school holidays and vacations, and the like.

Claim 15 is even more specific than claim 9 and no undue experimentation would be required to carry out the method of this claim, which calls for using a computer to input various

catagories of data, segmenting the campus, identify each need as an opportunity, generating (i.e., calculating) optimal facility locations and services, as in claim 9.

Claims 9 and 15-22 were rejected under 35 U.S.C. 112 as being indefinite.

In claims 9 & 18, the term "need" was considered relative. Again, the language of claims 9 and 18 was suggested by the examiner and his SPE to particularly point out and describe the invention and applicants do not understand why the examiners have changed their mind. The term "need" is of course relative but that does not render the claim indefinite. The user of the invention will set criteria to define need in a particular situation, e.g., if there is no college operated food service in the evening day-part within, e.g., one mile of a dormitory, there is a relative need which is identified by the system of the invention. In a computer system context, criteria are set by a user and those criteria are either met or not met. "Need" is merely a term used for a case where the criteria are not met. In order to narrow the issues during examination, the subparagraph in claims 9, 15, and 18 which included the word "need" has been deleted.

Claim 15 was found to be unclear as to whether drawn to a machine or article. This ground of rejection has been obviated by the current amendment to claim 15 which incorporates claim 1 rather than referring back to it, making the claim clearly independent.

Claims 16 and 17 have been amended to correct the dependency to claim 9.

Claim 9 was rejected under 35 U.S.C. §103 as being unpatentable over Halverson in view of Snyder and Fox.

Halverson discloses an apparatus and method for mass producing a "*dining event.*" Halverson's system is for one time catering events, not for optimizing dining facilities on a campus. Halverson does not teach, suggest, or make obvious a computer program, computer system, or method of generating optimal college campus dining facilities, locations, brands, design layouts, meal plans, and financial models for each such location. One skilled in this art would not regard Halverson as relevant to anything except creating "one-off" dining "events." Applicants' invention does not relate to one-off events such as catering events, but rather relates to calculating where dining facilities should be optimally located and configured on a college campus and how to make them most profitable.

The computer system and method of the invention enable segmenting a campus into geographic units and day parts; generating optimal dining facility locations and one or more

optimal services, brands, hours, design layouts, and meal plans corresponding to the facility locations and day parts; and generating a financial model for each of said optimal facility locations.

The Office Action clearly and explicitly recognized that Halverson does not teach substantial features and requirements of the invention, including campus geography data, campus architecture data, generating optimal facility locations and services, and financial models for each location. The Office Action cited secondary references, Snyder and Fox, to arguably supply the differences between Halverson and the invention.

Snyder does not supply the differences between the invention and Halverson. Snyder has nothing to do with dining facilities on a campus, which is a separate and distinct art from Snyder's art of generating class schedules. Snyder only discloses a method for automatically producing a schedule of classes for an educational institution having a plurality of teachers, a plurality of students, and a curriculum. An input to a computer system includes student information comprising, for one or more of the plurality of students, an indication of his level of competence with respect to the educational material of one or more modules. The Snyder computer system preferably produces a schedule of classes for teaching the educational material of at least some of the modules responsive to the curriculum information and the student information. (See Abstract).

One skilled in this art who is trying to locate dining facilities on a college campus would not look to a system for generating class schedules to guide them, nor would one who is designing a one-off dining event look to a system for generating class schedules to teach them how to locate dining facilities on a college campus and generate financial models for each such location. Halverson and Snyder are not properly combined because they are from very different fields of endeavor.

The Official Action explicitly recognized that neither Halverson nor Snyder teaches the main functions of the invention, generating optimal facility locations and services and a financial model for each such facility location, and refers to Fox.

Fox does not relate to the field of dining facilities, nor college campuses, but rather relates to the field of evaluating commercial retail sites, particularly grocery stores, mass marketers, and drug stores. See paragraph [0025], for example. Fox uses a hierarchical

multivariate model which includes a Tobit model, a Bayesian Heirarchy, a Multivariate Structure, vectors of predictor variables, and Markov Chain Monte Carlo estimations of Hierarchical Multivariate Type-2 Tobit models to evaluate the prospective commercial retail sites. Fox does not teach using a deterministic algorithm.

The rejection is based on a combination of Halberson's method for designing one-off dining events, Snyder's method of generating class schedules, and Fox's method of locating retail sites. Each of these methods is from a different field from each other as well as different fields from that of the invention. There would have been no suggestion to modify Halverson and combine it with Snyder and Fox.

As directed by the MPEP, § 2143.01,

> "A statement that modifications of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). ***'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" KSR [KSR *Int'l Co. v. Teleflex, Inc., 550 U.S. 398 (2007)*], 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)."

There is no objective reason to combine the teachings of Halverson, Snyder and Fox and no rational underpinning to support the conclusion of obviousness over such improper combination.

At most, the new combination of three references from disparate arts might support a prima facie obviousness rejection which can be rebutted by secondary indicia according to *Graham v. John Deere*, 383 U.S. 1 (1966).

The present invention has been very successfully commercialized by the assignee, Aramark, which uses the trademark "MarketMATCH," by a team led by one of the

inventors of the present invention, solving long-felt but previously unsolved needs, and has been recognized many times by experts in the field of the invention.

As set forth in the Declaration under 37 C.F.R. 1.132 of inventor Royale, "Aramark's "MarketMatch" Program, which is described and claimed in the above-referenced application * * * has achieved commercial success and has solved long-felt needs, as evidenced by the published articles and testimonials which are attached as exhibits [to the Royale Declaration]." Included among the exhibits were many testimonials, described in the Royale Declaration itself.

According to the relevant USPTO examination guidelines, secondary indicia of non-obviousness can overcome a prima facie obviousness type rejection under 35 U.S.C. 103 and should be fairly evaluated by the examiner. In the present case, the secondary indicia of non-obviousness are very strong. The Official Action did not even acknowledge applicants' extensive evidence of non-obviousness. The Office Action made no attempt to rebut said evidence. If properly considered, the submitted evidence should overcome the *prima facie* obviousness rejection over a combination of there references.

Reconsideration of the rejections under 35 U.S.C. 103 in view of the evidence being offered herewith and the arguments presented herein is respectfully requested.

Accordingly, it is believed that all of the claims are in condition for allowance. An early notice thereof is solicited.

Respectfully submitted,

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